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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,028	07/10/2000	Eric Michael Lunsford	PALM-3184.US.P	9582

7590 12/31/2003  
Wagner Murabito & Hao LLP  
Two North Market Street Third Floor  
San Jose, CA 95113

EXAMINER
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MENGISTU, AMARE

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/613,028

Applicant(s)

LUNSFORD ET AL.

Examiner

Amare Mengistu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 11-16, 21-28, 33-42 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-16, 21-28, 33-42 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_                      6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3,11-13, 22-25,33,35-38,46,48,49 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsui et al (5,493,365)**.
3. As to claims 1-3,11-13, **Matsui et al** (hereinafter **Matsui**) discloses a data input device comprising: a data input surface (fig.1 (11), fig. 2 (31), fig. 5 (21), figs.6, 7 (61); fig.9 (71)) for detecting a gesture performed thereon by a user and for facilitating recognition of said gesture as corresponding to a particular data input (col.2, lines 60- col.3, lines 11, 41-54, col.4, lines 3-18), therein said data input surface is responsive to a touch thereon (fig. 5, (26)); and a user removable template (fig. 1(13-15), fig. 2, fig.5 (24), figs. 6 and 7 (63,64); fig.9 (74)) having one of a plurality of marking configurations (figs. 3 and 4 (K1...K8) ), wherein each marking configuration facilitates operating said data surface in one of plurality function configurations ( (fig.3 (KU1...KU4), (CPU); also see, col.4, lines 36- col.5, lines 21); and wherein said user removable template is positioned over said data input surface for dividing said input surface into first data input area (fig.1 (13), figs. 6 and 7 (63)) and a second data input area (fig.1 (15); figs. 6 and

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7 (64)) , wherein said first input area is configured to facilitate recognition of one or more first gestures (fig.6 (63), col.5, lines 37-41), and wherein said second data input area is configured to facilitate recognition of one or more second gestures (fig.6 (64), col.5, lines 37- 46). It would have been obvious to one skill in the art to associated the first and second input area configurations (figs. 1 (13,14,15) and fig. 6 (63,64)) with one of said functional configurations of (fig.3 (KU1.KU4 and (CPU)), since this an alteranative way of operating to enter various information and commands to implement a plurality of key units.

As to claims 23 and 36, **Matsui** clearly teaches an electronic device comprising: a processor (fig.3 (45)); a bus coupled to said processor (fig.3 (the key units bus coupled to the processor)); an electronic display device coupled to a bus (fig.3, (48), col.4, lines 36-46, the display is controlled by the CPU (45), thus it is inherent that the display is coupled to the bus in order to display information); a memory (fig.3 (46,47)); a data input device (fig.3 (key units)) coupled to said bus, said data input device comprising: a data input surface (fig. 5 (21); fig.6 (61); fig.7 (61a);fig.9 (71)) for detecting a gesture performed thereon by a user and for facilitating recognition of said gesture as corresponding to a particular data input, and a user removable template positioned over said data input surface for dividing said data input surface into a first data input area (fig.5 in (21) the area for (26) and also see, figs. 6,7 and 9) and a second data input area ((fig.5 in (21) the area for (24) and also see, figs. 6,7 and 9), wherein said first data input area is configured to facilitate recognition of one or more first gestures (col.5, lines 22-

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35), and wherein said second data input area is configured to facilitate recognition of one or more second gestures (col.5, lines 22-35).

As to claims 24,25,37,38, **Matsui** discloses a first gesture corresponds to a plurality of handwriting strokes (fig.5 (26) col.5, lines 22-36) and a second data input area is a keyboard (fig.5 (24), col.5, lines 22-36).

As to claims 33 and 46, **Matsui** also teaches that the first module is a display (fig.7 (62)) and a second module is an input device (fig.7 (63,64)).

As to claims 22 and 48, the user removable data input device includes a mechanism for automatically configuring to recognize said user removable data input device (col.4, lines 23-35) as taught by **Matsui**.

In regard to claims 35 and 49, **Matsui** discloses an electronic system having one or more communication ports (see, fig.1 (16); fig.2 (36-38,43); fig.3, the key unit communicating with CPU; fig.7 (75)).

4. Claims 4-6,14-16,21,26-28,39-41 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Matsui et al (5,493,365)** in view of **Ganthier et al (5,865,546)** and **Sylvan et al (5,572,573)**.

As to claims 4-6,14-16,21,26-28,39-41 and 47, **Matsui** discloses a removable input device but did not explicitly disclose that the removable keys could be a shortcut key. However, one skill in the art would have recognized that the keyboard of **Matsui's** would have a function keys "shortcut keys" and an application programs which provides these "shortcut keys" to assist such user, whereby a function may be invoked by pressing these function keys.

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**Matsui** has also failed to disclose the input device including a game control keys. However, **Ganthier et al** discloses a keyboard module and suggest that a user can replace each input device module with a different input device (see, abstract; col.2, lines 56-64). Thus, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to replace one of the input device with a game control device as taught by **Ganthier** into the device of **Matsui** because this will allow the user with more flexibility to control and minimizing the amount of input device on the keyboard.

**Matsui** has also failed to disclose that the electronic system is a PDA. The patent of **Sylvan et al** is cited to teach that it is well known for PDA to have both touch pad or a keyboard (see, figs.1, 2, 8 and 9).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use a PDA with a keyboard or touch screen as taught by **Sylvan et al** into the device of **Matsui**, since this will provide user with more compact and efficient electronic input system.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-6,11-16,21-28,33-42,47-49 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

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Amare Mengistu  
Primary Examiner  
Art Unit 2673

A.M

December 23, 2003